



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY MAGLICA

Appeal No. 97-3131
Application 07/411,576

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TRANSMITTAL LETTER

Serial Number 07/411,576
Filing Date: 09/22/89
Appellant: Anthony Maglica
Examiner: M.H. Tung, A.U. 2901

Board of Patent Appeals and Interferences
Hon. Commissioner for Patents
Washington, D.C. 20231

Dear Sirs:

Due to a printing error, two lines of text were missing from the top of page three
(3) in APPLICANT'S SUPPLEMENTAL REPLY TO THE ORDER TO SHOW CAUSE
filed September 4, 2001. Kindly substitute therefore the enclosed APPLICANT'S
CORRECTED SUPPLEMENTAL REPLY TO THE ORDER TO SHOW CAUSE.

DC7600.1

CERTIFICATE OF HAND DELIVERY

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being hand delivered on the date shown below to the Commissioner for Patents, Washington, D.C. 20231.

Fred Thompson

Name of Person Delivering Paper

Fred J L

Signature of Person Delivering Paper

September 6, 2001

Date of Delivery

The Commissioner is hereby authorized to charge any fees necessary in
connection with this Corrected Supplemental Reply to Lyon & Lyon LLP's Deposit
Account No. 12-2475.

Respectfully Submitted,

LYON & LYON LLP

Dated: 9/6/2001

By James T. Carmichael
James T. Carmichael
Reg. No. 45,306

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TECH CENTER 1600/2900

47th Floor
633 West Fifth Street
Los Angeles, CA 90071-2066
(213) 489-1600

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Ex parte ANTHONY MAGLICA

Appeal No. 97-3131
Application 07/411,576

APPLICANT'S CORRECTED SUPPLEMENTAL REPLY TO THE ORDER TO SHOW
CAUSE

Serial Number 07/411,576

Filing Date: 09/22/89

Appellant: Anthony Maglica

Examiner: M.H. Tung, A.U. 2901

Board of Patent Appeals and Interferences
Hon. Commissioner for Patents
Washington, D.C. 20231

Sirs:

This Supplemental Reply addresses the Examiner's RESPONSE TO
APPELLANT'S REPLY TO THE ORDER TO SHOW CAUSE ("Response") mailed
August 1, 2001.

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Fred Thompson

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Judith

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September 6, 2001

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The Order To Show Cause, mailed December 1, 1998, stated that the Examiner had imposed new grounds of rejection in the Advisory Action dated November 12, 1996, that the new grounds were repeated in the Examiner's Answer dated February 21, 1997, and that Appellant failed to address the new grounds. However, the Examiner in her Response argues in essence that in fact there were no new grounds in the Advisory Action or in the Examiner's Answer, and that the outstanding 35 U.S.C. § 112, first paragraph, rejection actually continues from the final rejection leading to the prior appeal no. 93-0363. (Response at p. 3-4.)

While there is no dispute that the claimed invention has been rejected under 35 U.S.C. § 112, first paragraph, since the very first office action, the record makes abundantly clear that the grounds of that rejection set forth at page 4 of the Examiner's Answer are in fact new. The record also makes clear that Appellant's amendment filed September 5, 1996 did not necessitate the additional grounds of rejection as the Examiner so forcefully argues in her Response. (See Response at p. 3-4.) Rather, the Examiner could have previously asserted the new grounds of rejection, but simply did not. Indeed, it was the Examiner's failure to timely raise the new grounds followed by her subsequent failure to adhere to applicable procedures with respect to raising new grounds of rejection in an Answer that significantly contributed to, if not entirely caused, the current state of affairs. Appellant should not be made to pay the ultimate price--dismissal of the present appeal--under such circumstances.

A dismissal of the present appeal would be particularly prejudicial. As stated at p. 5 of the Response, "the main dispute which has been at the heart of the application since its inception" in 1989 has been the shape of the flashlight head. However, the

Board has now decided this issue in Appellant's favor in Appellant's co-owned companion application 07/410,965. (See pages 20-22 of the Board's Decision on Appeal re-mailed October 19, 1998, in Appeal No. 95-4085.)¹ The same evidence the Board found persuasive in that Appeal has been entered in the record in this case and fully discussed in Appellant's Appeal Brief. As a result, the only issues remaining in this appeal are the two new grounds that the Examiner raised for the first time after Appellant's Appeal Brief was filed September 5, 1996, yet could have been raised years earlier, and which have been shown to be totally without merit in Appellant's Response to the Order to Show Cause.

The Examiner first raised these new grounds in the Advisory Action mailed November 12, 1996. As set forth in the Advisory Action and the Examiner's Answer, the new grounds of rejection relate to two points of new matter allegedly added by Appellant's September 5, 1996 amendment. The alleged new matter is identified as follows:

- a) The smooth portion of the barrel between the threaded end (bulb end) and the knurled barrel is proportionally longer than shown in the original formal and the original mechanical drawings.
- b.) In Fig. 3, the distance between the outermost concentric circle and the next concentric circle toward the inside is proportionally wider than in the original formal or the original mechanical drawings. Although applicant asserts that this is for consistency with the proportions of the

¹ A copy of the Boards's second Decision on Appeal (Paper No. 49), which was re-mailed October 19, 1998, in Appellant's companion application 07/410,965 is being attached hereto as the PTO has been unable to locate Appellant's companion application for over a year.

flashlight head to the barrel and to the threaded end (shown in Figs. 1 and 2), the flashlight head in the new drawing is proportionally wider than in the original disclosure.

(Id.)

One need only review the September 3, 1996 Substitute Declaration of Gerald R. Parker ("Substitute Parker Declaration"), which was submitted with the September 5, 1996 amended drawing, to conclude that the new grounds were not necessitated by Appellant's amendment. The Substitute Parker Declaration attaches as Exhibits A, B, and C, respectively, the following: figures 1-4 submitted to the PTO with the Response Pursuant to 37 C.F.R. 1.196(b)(1) mailed August 23, 1993; figures 1-4 showing proposed drawing changes to Exhibit A and which was submitted with an Amendment After Final filed February 27, 1996; and figures 1-4 submitted September 5, 1996, and which are currently on appeal. In each of these drawings the smooth portion of the barrel between the threaded end and the knurled portion of the barrel has remained the same while the other linear dimensions of the claimed flashlight design have also remained the same or increased slightly. In fact, the linear dimension of the smooth portion has not changed since the 1/7/92 drawings considered in the first appeal, while the other linear dimensions of the claimed flashlight design have remained the same or increased slightly. Similarly, the diameter of the flashlight head in Fig. 3, which is represented by the outermost circle in each of these drawings, has not changed. Nor has the diameter of the barrel changed in these drawings so as to alter the proportionality between the head and barrel. And with respect to the next concentric circle in Fig. 3, if anything, it has a slightly larger diameter in the September 5, 1996

drawings than in the two earlier sets of drawings attached to the Substituted Parker Declaration, or the 1/7/92 drawings reviewed in the first appeal.

The record, therefore, clearly shows that the Examiner could have raised the two new grounds of rejection in either the December 5, 1995 Final Office Action, which is currently being appealed, or the Advisory Action mailed March 19, 1996. In both instances, however, the Examiner failed to raise these new grounds. Instead, they were not raised until after Appellant had already filed an appeal brief in the instant appeal. Indeed, because the September 5, 1996 drawings have not changed with respect to the points now complained of from the January 7, 1992 drawings reviewed by the Board during the first appeal, the Examiner could have addressed these issues in connection with the first appeal.

The fact that Appellant's September 5, 1996 Amendment did not necessitate the new grounds of rejection is also evidenced by the Examiner's entry of Appellant's Amendment. Had Appellant's Amendment necessitated the new grounds, the Examiner would have been precluded from entering Appellant's substitute drawing. Manual of Patent Examining Procedure ("MPEP") § 1207 at p. 1200-12 (Rev. 2, July 1996) ("Of course, if the amendment necessitates a new search, raises the issue of new matter, . . . or otherwise introduces new issues, it will not be entered.") Thus, if the Examiner believed that the Amendment after final introduced new issues, the Examiner was prohibited from entering it. (Id.)

Further, if the Examiner believed that the Appellant's Appeal Brief failed to respond to any outstanding ground of rejection, the Examiner was obligated to notify Appellant and provide a 1-month period to correct the defect by filing a supplemental

brief. MPEP § 1206 at p. 1200-6, -9 (Rev. 2, July 1996). No such notice was provided. Indeed, none of the grounds on which the 35 U.S.C. § 112, first paragraph, rejection was based in the final Office Action mailed December 5, 1995 or in the Advisory Action mailed March 19, 1996 were asserted by the Examiner on Appeal. Rather, the only grounds relied on were those newly asserted in the Advisory Action mailed November 12, 1996. Thus, Appellant's September 5, 1996 Amendment was effective in overcoming all of the previously stated 112 grounds.

The Examiner also failed to properly raise the new grounds for rejection in the Examiner's Answer. First, under the procedures applicable at the time, the Examiner was required to review the new grounds with her supervisory primary examiner (SPE) and obtain her SPE's signature. MPEP § 1208.01 at p. 1200-20, -21 (Rev. 2, July 1996). The record does not reflect that either of these requirements were satisfied in the instant case. Furthermore, if the decision is made to introduce new grounds of rejection in the Examiner's Answer, rather than by reopening ex parte prosecution, the Examiner is required to clearly identify the new grounds. Id. This requirement was established so that the Board and Appellant are provided with clear notice when the Appellant is required to file a reply to avoid dismissal. Id. at §§ 1208.01, 1208.03. Such a policy is clearly sound and is designed to avoid the very circumstances presented here. Indeed, the applicable MPEP guidelines at the time the Examiner's Answer was filed only authorized dismissal of an appeal for failing to timely file a reply brief when an examiner's answer expressly stated that it included a new ground of rejection. Id. at § 1208.03.

The Examiner in this case had no authority to impose a new ground of rejection without the review and signature of her SPE, or to enter and reject subject matter thought to be new, at any time after the Appeal Brief was filed on September 5, 1996. Applicant cannot now be faulted, and should not now be prejudiced, for not addressing the merits of an ultra vires rejection that the Examiner failed to properly identify in the Examiner's Answer as constituting a new ground of rejection. Applicant had every right to, and did in fact, expect that no (prohibited) new grounds were being added after the Appeal Brief was filed, as none were identified in the Examiner's Answer.

Rather than wait for the Examiner to set the one-month period to which appellant is entitled under MPEP § 1206 (Rev. 2, July 1996), appellant has now submitted a Reply Brief addressing the new grounds of rejection. The Examiner should now enter the Reply Brief and return the case to the Board for decision.

Accordingly, the appeal should proceed and be decided on the merits. Or, at the very least, the Board should return the defective Examiner's Answer to the group director's office for preparation and filing of a properly reviewed and signed substitute Examiner's Answer. MPEP §1208.01 (Rev. 2, July 1996, page 1200-20) ("The Board will return to the group director's office any answer containing . . . a new ground of rejection, where such answer does not bear the supervisory primary examiner's signature.").

To the extent necessary to have the appeal heard, applicant hereby requests reinstatement of the appeal under 37 CFR § 1.193(b)(2)(ii). However, the request is not believed necessary, given the discussion above. To the extent that such reinstatement

request is necessary for hearing the appeal, the Reply Brief will serve as the Supplemental Brief contemplated by 37 CFR § 1.193(b)(2)(ii).

The Commissioner is hereby authorized to charge any fees necessary in connection with this Corrected Supplemental Reply, or in connection with the Reply Brief, to Lyon & Lyon LLP's **Deposit Account No. 12-2475**.

Respectfully Submitted,

LYON & LYON LLP

Dated: 9/6/01

By 
James T. Carmichael
Reg. No. 45,306

47th Floor
633 West Fifth Street
Los Angeles, CA 90071-2066
(213) 489-1600